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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,859	08/23/2001	Masahiko Enari	09812.0651	9497

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EXAMINER
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REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/935,859

Applicant(s)

ENARI, MASAHIKO

Examiner

Ramsey Refai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Responsive to Request for Continued Examination (RCE) filed April 26, 2007. Claims 1-5 have been canceled. Claims 6-13 are new. Claims 6-13 are now presented for examination.

### *Response to Arguments*

1. Applicant's arguments have been fully considered but they are not persuasive.
  - In the remarks, the Applicant is arguing that Rautia discloses a single communication channel and fails to disclose two different communication channels.
  - In response, the Examiner respectfully disagrees. Rautila teaches that the mobile station 10 gains access to the *Internet 150* (first communication channel) to select an electronic shop server 40 to logon to, to browse the content titles available at the electronic shop server. A user may then select a particular content to purchase and receives a unique order number. The user then uses *hotspot network 50* (second communication channel) to download the selected content using the received unique order number. (see column 6) Rautila clearly uses two different communication channels and therefore meets the scope of the claimed limitation.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Independent claims 6 and 10 contain the limitation “ *obtaining an identification code for individually identifying the retrieved electronic content item.*” No support for this new amendment can be found in the applicant’s disclosure. The specification does not define the term individually.

These claims also contain the limitations “ *retrieving the selected electronic content item via a first communication channel*”, “ *enabling the customer to purchase, via a second communication channel, the second communication channel being different from the first communication channel, the retrieved electronic content item corresponding to the identification code*” . No support for these limitations can be found in the Applicant’s disclosure. The disclosure does not teach a first and a second communication channel nor that these two communication channels are different.

Claims 7-9 and 11-13 depend on claims 6 and 10 respectively, therefore are rejected for the same reasons as their respective parent claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 6 (and similarly in claim 10) recites the limitations “ *retrieving the selected electronic content item via a first communication channel*” and then later includes the limitation of “ *enabling the customer to download the purchased electronic content item*” . It is not clear why the electronic content item is being retrieved prior to the step of inputting the identification code at the store information terminal. It is also unclear why the electronic content

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item is being downloaded after being purchased since the electronic content item has already been retrieved in the retrieving step. Furthermore, it is not clear whether the “ purchased electronic content item” is the same as “ the selected electronic content item” in the retrieving step. Clarification is requested.

Claims 7-9 and 11-13 depend on claims 6 and 10 respectively, therefore are rejected for the same reasons as their respective parent claim.

*Claim Rejections – 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 6-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Rautila (US Patent No. 6,714,797).

8. As per claim 6, Rautila teach a method for providing electronic content to a customer using a remote user terminal and a store information terminal, the method comprising the steps of:

accessing a menu including a plurality of electronic content items available for purchase using the remote user terminal (column 6, lines 2-7);

selecting an electronic content item using the remote user terminal (column 6, lines 5-7);

retrieving the selected electronic content item (column 6, lines 14-17) via a first communication channel ( column 6, line 1; internet 150)

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obtaining an identification code for individually identifying the retrieved electronic content item (column 6, line 35-40, column 8, lines 31-37);

inputting the identification code at the store information terminal (column 6, lines 50-53);

enabling the customer to purchase (column 6, lines 53-64), via a second communication channel, the second communication channel being different from the first communication channel (hotspot network 50), the retrieved electronic content item corresponding to the identification code (column 6, lines 50-64),; and

enabling the customer to download the purchased electronic content item (column 6, line 53-column 7, line 5).

9. As per claim 7, Rautila teaches downloading the purchased electronic content item to a portable recording medium (column 4, lines 15-25; downloading content to mobile station 10).

10. As per claim 8, Rautila teaches wherein the menu including the plurality of electronic content items available for purchase is located on a server accessible by the remote user terminal via a network (column 6, lines 2-8).

11. As per claim 9, Rautila teaches wherein the step of obtaining an identification code for individually identifying the retrieved electronic content item comprises downloading the identification code to a portable recording medium (column 6, lines 35-38; unique order number downloaded to mobile station 10).

12. As per claims 10-13, these claims contain similar limitations as claims 6-9 above, therefore are rejected under the same rationale.

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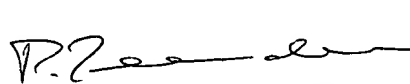
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai  
Examiner  
Art Unit 3627  
May 25, 2007  
/RR/

 5/30/07  
F. RYAN ZEENDER  
SUPERVISORY PATENT EXAMINER